

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOMTOM, INC.,
Petitioner,

v.

BLACKBIRD TECH, LLC d/b/a BLACKBIRD TECHNOLOGIES, LLC
Patent Owner.

Case IPR2017-02023
Patent 6,434,212

Before DEBRA K. STEPHENS, THOMAS L. GIANNETTI, and
CHRISTA P. ZADO, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

ORDER

Conduct of the Proceeding
37 C.F.R. § 42.5

On April 24, 2018, the Supreme Court held that a decision to institute under 35 U.S.C. § 314 may not institute on less than all claims challenged in the petition (*SAS Inst., Inc. v. Iancu*, 2018 WL 1914661, at *10 (U.S. Apr. 24, 2018)). In our Decision on Institution, we determined that Petitioner demonstrated a reasonable likelihood that it would establish that at least one of the challenged claims of U.S. Patent 6,434,212 ('212 patent) is unpatentable (Paper 7, 36). Specifically, Petitioner challenged claims 1–8 in the Petition on the following grounds:

Claims	Basis	References
1–8	§ 103(a)	Jimenez (US 4,367,752) (Ex. 1002) (hereinafter, “Jimenez”), Levi (US 5,583,776) (Ex. 1003) (hereinafter, “Levi”), and “knowledge of a person having ordinary skill in the art”
1–8	§ 103(a)	Jimenez, Ebeling (US 6,145,389) (Ex. 1004) (hereinafter “Ebeling”), and “knowledge of a person having ordinary skill in the art”

(Paper 1, 5–6) We instituted on:

Claims	Basis	References
1–5	§ 103 (a)	Jimenez, Levi, and “knowledge of a person having ordinary skill in the art”

(Paper 7, 36). We modify our institution decision to institute on all of the challenged claims and all of the grounds presented in the Petition.

Specifically, we modify our decision to include the Petitioner’s asserted

ground that under 35 U.S.C. § 103(a), (i) claims 6–8 are unpatentable over Jimenez, Levi, and “knowledge of a person having ordinary skill in the art” and (ii) claims 1–8 are unpatentable over Jimenez, Ebeling, and “knowledge of a person having ordinary skill in the art.”

The parties shall confer to discuss the impact, if any, of this Order on the current schedule. If, after conferring, the parties wish to change the schedule or submit further briefing due to this Order, the parties must, within one week of the date of this Order, request a conference call with the panel to seek authorization for such changes or briefing.

In consideration of the foregoing, it is hereby:

ORDERED that our institution decision is modified to include review of all challenged claims and all grounds presented in the Petition, specifically:

Claims 1–8 under 35 U.S.C. § 103(a) as obvious over Jimenez, Levi, and “knowledge of a person having ordinary skill in the art”; and

Claims 1–8 under 35 U.S.C. § 103(a) as obvious over Jimenez, Ebeling, and “knowledge of a person having ordinary skill in the art”; and

FURTHER ORDERED that Petitioner and Patent Owner shall confer to determine whether they desire any changes to the schedule or any further briefing, and, if so, shall request a conference call with the panel to seek authorization for such changes or briefing within one week of the date of this Order.

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